

Remarks

This transmittal is presented in response to the third office action and is believed to completely resolve each issue as raised by the examiner.

OA Item #1: Rejection under 35 USC § 251 – Improper recapture:

The examiner has rejected claims 36-41 as an improper recapture of broadened claimed subject matter surrendered in the application for patent upon which the present reissue is based. The examiner noted that, “A broadening aspect is present in the reissue which was not present in the application for patent”. The examiner argues that the basis for the rejection is that, “The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application.” The examiner also reiterated patent claim 8 (with emphasis on deleted limitations) and noted that it corresponded to surrendered subject matter. Applicant respectfully notes no further specificity or basis was provided in the office action regarding what established the surrendering of the limitations in question. Accordingly, applicant respectfully suggests that the applicant is disadvantaged in his ability to argue against such surrendering. Nevertheless, applicant provides the following argument against the noted surrendering, believing applicant’s argument to cover all possible categories of surrender.

Applicant readily agrees that there is a broadening aspect in the pending reissue. Applicant further readily acknowledges that those limitations of patent claim 8 that were *“emphasized”* by the examiner (i.e. a hydraulic motor and an exit port) were omitted from pending claims 36-41. However, applicant respectfully traverses the examiner’s position that the now deleted limitations were surrendered during the prosecution of the parent application. Applicant avers that applicant satisfies the requirement of 35 USC § 251 which states, “Whenever any patent is, ...deemed wholly or partly inoperative or invalid, ... by reason of patentee claiming more or less than he had a right to claim in the patent, the Director shall, ... reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application ...”. In addition to other reasons, the discovery of new art necessitated the

modification of the scope of the claims. However, applicant realizes that although applicant satisfies 35 USC § 251, 251 is silent with respect to recapture. Therefore, in order to establish applicant's conclusion that improper recapture does not exist and that the limitations omitted were not previously surrendered, applicant refers to MPEP § 1412.02 under the heading "CRITERIA FOR DETERMINING THAT SUBJECT MATTER HAS BEEN SURRENDERED". The first sentence under the noted heading is repeated here for reference:

If the limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application, the omitted limitation relates to subject matter previously surrendered by applicant, and impermissible recapture exists.

Applicant respectfully points out, that the only limitation that was presented/argued/stated in the original application in claim 8 to make the claim allowable over a rejection or objection was the limitation of "non-cavitation". Applicant further respectfully points out that as was noted in applicant's previous office action response, the surrendered limitation is found in each claim of claims 36-41.

Taken a step further, MPEP § 1412.02 provides three distinct examples of how subject matter may be surrendered, namely: Example (A) - Argument without amendment, Example (B) – Amendment without argument, and Example (C) – Examiner's reasons for allowance without applicant counter. Each example will be addressed below.

With respect to example "A", the following summarizes the arguments without amendments presented in the prosecution of the parent application:

- 1) In the 12/29/98 OA response: The limitation of "non-cavitation" was argued to be not new matter.
- 2) In the 12/29/98 OA response: The limitation of a "non-bubble liquid emitting device" was argued to overcome a 35 USC § 102 rejection of the D'Andrade reference. Applicant notes that applicant stated that the "D'Andrade reference does not have a "non-bubble liquid emitting device""", and that (original) claim 8 included the limitation of an "exit port for the emission of hydraulic fluid". However, as has been pointed out to the applicant in

many an office action, statements of intended use do not positively limit the claim. Thus, while an “exit port” is considered a limitation to claim 8, “for the emission of hydraulic fluid”, being a statement of intended use, is therefore not considered a limitation to claim 8.

- 3) In the 12/29/98 OA response: The limitation of a “non-cavitation” was argued to overcome a 35 USC § 102 rejection of the Henkin reference.

Of the two limitations listed above, the “non-cavitation” limitation, (as noted) is included in all of claims 36-41, and the limitation of “non-bubble liquid emitting device”, although not in any of claims 36-41, was never presented in (original) claim 8. Thus, applicant respectfully suggests by reason of example “A”, that there is no limitation not included in claims 36-41 that was surrendered in claim 8.

With respect to example “B”, there are no limitations by amendment that were made to claim 8 that are not included in claims 36-41. Thus, applicant respectfully suggests by reason of example “B”, that there is no limitation not included in claims 36-41 that was surrendered in claim 8.

With respect to example “C”, example “C” requires that the examiner’s reasons for allowance state, “that it was limitation A which distinguished over a potential combination of references X and Y”. The examiner’s reasons for allowance are general broad based reasons that essentially recite that, “None of the prior art, alone or in combination, teaches Applicant’s invention of ...” and then reiterate a summary of the applicant’s invention. Further, the examiner’s reasons are stated in the alternative (i.e. applicant’s invention of this *or* that). Accordingly, no specific limitation “A” is established as defining over a potential combination of references “X” and “Y”. Thus, applicant respectfully suggests by reason of example “C”, that there is no limitation not included in claims 36-41 that was surrendered in claim 8.

Conclusion:

Applicant respectfully suggests that applicant's application is free of improper recapture. Applicant submits that the arguments presented herein have placed the claims in condition for allowance. Action in accordance therewith is earnestly solicited.

If the Examiner has any questions or comments which may be resolved over the telephone, he is requested to call Michael R. Schramm at 801-625-9268 (wk) or at 435-734-2599 (hm).

DATE: January 02, 2004

Respectfully submitted,



Michael R. Schramm